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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/607,185

06/26/2003

David L. Patton

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05/28/2008

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EXAMINER

REESE, DAVID C

ART UNIT

PAPER NUMBER

3677

MAIL DATE

DELIVERY MODE

05/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/607,185	Applicant(s) PATTON ET AL.	
	Examiner David C. Reese	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

THIS NON-FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 2/12/2008.

- Claims 2-3 are canceled.
- Claims 1 and 4-6 are pending.

Claim Rejections - 35 USC § 102

[1] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[2] Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as anticipated by Norsam Technologies, “Ion-Beam Inscriptions” (see pages 2-3 of the submitted document, “What the GIA Study Overlooked”, <http://www.jckonline.com/article/CA635467.html>, 4/1/1999), because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 1, Norsam discloses of a gemstone having a micro-discrete indicia formed on a surface of said gemstone (see paragraph 2, "...direct a beam of gallium ions onto a diamond substrate...creates a bulging effect of "raised lettering" at the surface of the gemstone in the vicinity of...the high energy ions") wherein said micro-discrete indicia image [was formed using near-field optics]*, has a length no greater than about 10 microns and a height no greater than about 2 microns (see paragraph 3, "...at the sub-micron level..."), said gemstone having an altered color (the carbon deposits) at the location of said micro-discrete indicia without ablating the surface of said gemstone, [said altered color resulting from said near-field optics forming said micro-discrete indicia image]*.

Examiner's note*: the use of near field optics to make the image/altered color is a process step in a product claim and holds little patentable weight. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F2d 742, 180 USPQ 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964).

Re: Claim 4, Norsam discloses: wherein in said micro-discrete indicia is provided at a predetermined coordinates on said gemstone ("...we can precisely direct a beam of gallium ions onto a diamond substrate").

Re: Claim 5, Norsam discloses: wherein said micro-discrete indicia provides information ("...logos, line drawings, unique typography and special "millennium messages"...can inscribe any brand or message...") with regard to said gemstone.

Re: Claim 6, Norsam discloses wherein said information comprises any of the following: size, type, manufacturer, retailer, owner, producer, country of origin, mine ("...logos, line drawings, unique typography and special "millennium messages"...can inscribe any brand or message...").

Response to Arguments

[3] Applicant's remarks filed 2/12/2008 regarding rejections under 35 U.S.C. 103 have been fully considered. After further consideration of the claims and newly found art, however, the Examiner has withdrawn all previous rejections over Smith, US- 6,187,213 in view of case law, in further view of Weir, US-6,710,943 (evidence), and in even further view of applicant's own disclosure; and has presented a new grounds of rejection in view of Norsam Technologies, "Ion-Beam Inscriptions". Consequently, all arguments are considered moot to said new grounds of rejection. Please also note the additional notice of reference cited showing further art regarding this type of inscription process.

Art Unit: 3677

Conclusion

[4] THIS ACTION IS NON-FINAL

[5] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached at (571) 272-6987. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese

/D. C. R./

Examiner, Art Unit 3677

/Victor Batson/

Supervisory Patent Examiner, Art Unit 3677